

### REMARKS

#### **Claim Rejections – 35 U.S.C. § 112**

Claims 1-4 and 13, 15-18 were rejected under 35 U.S.C. § 112 ¶2 for being indefinite for not distinctly claiming the subject matter which the Applicants regard as their invention. With regards to claims 1-4, the Examiner stated there was an inconsistency between the preamble and the body of the claim. Applicants have amended the preamble to clarify the subject matter that the Applicants regard as the invention, as suggested by the Examiner. Allowance of claims 1-4 is respectfully requested

Claims 13, 15-18 were rejected for antecedent purpose. Claim 13 has been amended to state that the device comprises at least a pair of guide rails. Claim 13 as now amended is believed to overcome the Examiner's § 112 rejection. Accordingly, Applicants request that the Examiner remove the rejection under § 112 of claims 13 and 15-18, and claims 13 and 15-18 be passed to allowance.

#### **Claim Rejections - 35 U.S.C. § 102**

Claims 1-7, 9-11, and 13 were rejected under 35 U.S.C. 102(e) as being anticipated by Agee, U.S. Pat. No. 6,546,880. Applicants have amended independent claim 1 to state the claimed combination is capable of supporting at least 100 pounds. Applicants have amended independent claims 5 and 10 to state that the claimed column and table are capable of supporting a patient. The prior art does not show such a table, as the portion of Agee cited by the Examiner is not capable of such support, and allowance of the claims is respectfully requests.

As Applicants previously pointed out, Agee discloses a work table, such as a draftsman's table (Col. 1, lines 30-50). Applicants further take judicial notice that a person having ordinary skill in the art of both examination tables and/or draftsman's tables would understand that Agee is not a comparable to an examination table and would not be capable of supporting a person or a heavy weight, as is the recited purpose of the present application and claims. Agee is not capable of performing the intended use of the present invention, which is an examination table that can support a person. Agee does not show, teach, or suggest a structure that could support a patient, but only contemplates supporting a 'relatively heavy' computer, which is in the range of 30-40 pounds. Accordingly, claims 1, 5, and 10 are not anticipated by Agee, and allowance of claims 1, 5, and 10, and dependent claims 2-7, 9, 11, and 13 is respectfully requested

More importantly, Applicants reiterate that Agee does not disclose all of the recited elements of the present claims. A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention. MPEP § 2141.02 *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 U.S.P.Q. 303 (Fed. Cir. 1983). Agee uses and includes several elements that are not arranged as claimed and teach away from the spatially arranged elements of the present claims. In independent claim 1, from which claims 2-4 depend, the elements are recited for a distinct purpose, which is keeping a predetermined distance between a pair of nesting sleeve members. Agee does not show such a structure. That is, Agee does not show the described camming mechanism for the intended use, which is an important aspect of the present invention. Contrary to the Examiner's assertions, the claimed structure is structurally different from that of Agee. The present arrangement allows for the sleeve members to easily slide relative to one another without being compromised, regardless of the weight or force applied to the sleeve members. Agee does not show sleeve members as claimed and arranged, as it is only contemplated for use on a work table discussed for supporting a computer.

Further, Agee does not show a camming mechanism as spatially arranged in the claims. Elements must not just be locatable in the prior art, but the elements must be arranged as required by the claim (MPEP §2131). For example, claim 2 requires the guide rail to be attached to one of the noted sleeve members and the cam followers to be attached to the other of the sleeve members. Figure 3 of Agee shows the cam members 31 supported by a chain 40 and sprocket 44 arrangement, and not a cam member or members spatially positioned on an opposing sleeve member as claimed in the present invention. Because Agee does not show the recited elements of the claims in the claimed arrangement, Agee cannot anticipate the claims. Allowance of claims 1-4 is requested.

Agee does not show a pair of nesting sleeve members as recited in claim 5. Rather, it shows a base section and a sleeve section. Even if the base section of Agee as a whole was considered a sleeve section, it is not a nesting sleeve section as presently claimed. Figure 3 of Agee shows only a portion of the support column and not an entire support column. The entire base section is not shown, but only one end section of the base section. The entire base section, which is needed for support, does not nest with the sleeve section. The portion of the base shown in Figure 3 could not support a table in a functional manner, as the table of Agee would fall over without the other end of the base section, as shown in Figure 1. Agee should be properly read as the specification recites; it has two separate base sections (12 and 13, see Figure 1) and not a sleeve section, wherein each of the separate base sections separately interact with the ends of a lift 17. As such, the base section 12

and 13 are not analogous to a sleeve section as claimed, and do not nest with the lift 17. If Agee did have nesting sections as claimed in the present application, base sections 12 and 13 would interfere with one another and Agee would become inoperable. Agee would have to be modified to operate as presently claimed, to a degree that Agee would be inoperable and unsatisfactory for its intended purpose, which is a draftsman's table, and does not anticipate the present claims. MPEP §2143.01(V) *In re Gordon*, 733 F.2d 900, 221 U.S.P.Q. 1125 (Fed. Cir. 1984).

Also, Agee does not show a guide rail supported by a sleeve section and the cam members supported by the other sleeve section, as is recited in claim 5. Figure 3 of Agee shows the cam members 31 supported by a chain 40 and sprocket 44 arrangement, and not a cam member or members supported by a sleeve member as claimed in the present invention. Because Agee does not show the recited elements in the claimed arrangement, Agee cannot anticipate claim 5, or claims 6, 7, and 9 that depend from claim 5. Allowance of these claims is requested.

Agee does not anticipate independent claim 10, or claims 11 and 13 that depend from claim 10. Agee has a base section and one sleeve section, not a plurality of sleeve sections. Agee does not disclose the elements of the present invention, as claimed in claims 10-13. Agee should not be reconfigured, rearranged or broken apart into separate elements in a manner that would make it inoperable to suggest that it meets the elements of the present claims. Agee does not have a column having a plurality of nesting sections as is presently claimed, and Agee does not anticipate independent claim 10, or dependent claims 11 and 13 of the present invention.

Agee does not show an examination table or similar table as is covered by the scope of the present claims. The table of Agee is inoperable as an examination table. Agee does not have or show nesting sleeve sections and does not have a plurality of nesting sleeves together with a base. Agee does not have a guide rail and cam members as recited and claimed in the present invention. As such, Agee does not anticipate the present claims, and allowance of claims 1-7, 9-11 and 13 is requested.

### **Claim Rejections – 35 U.S.C. § 103**

Claims 8 and 14 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Agee in view of Santoro et al., U.S. Pat. No. 6,682,030. Claims 10-18 were rejected under 35 U.S.C. §103(a) as being unpatentable over Blyshak et al., U.S. Pat. No. 6,886,200 in view of Agee. As noted above, Agee does anticipate or suggest the features of the present invention, as currently claimed in claims 5 and 10, and claims 5 and 10 are believed to contain allowable subject matter.

Furthermore, it would not be obvious to combine Agee and Santoro or Blyshak to arrive at the present invention. "Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination." *Carella v. Starlight Archery and Pro Line Co.*, 804 F.2d 135, 140, 231 U.S.P.Q. 644, 647 (Fed. Cir. 1986). There is no teaching in Agee that it may work as an examination table, nor is there any teaching to modify Santoro or Blyshak to arrive at the claimed examination table. "The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in Applicant's disclosure." MPEP § 2143 (citing *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991)). Agee is incapable of supporting a patient; the only reasonable expectation to incorporate a structure similar to Agee comes from the present disclosure, and Blyshak and Santoro do not overcome the limitations of Agee to arrive at the present invention. Accordingly, claims 8 and 10-18 are believed to be allowable, and allowance is respectfully requested.

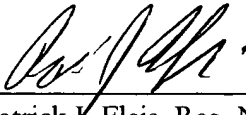
Applicants would once again like to point out that the Examiner did not address all of the elements of the recited claims, specifically the dependent claims, such as the weight parameters of claim 12, or the height ranges of claims 16-18. Blyshak makes no suggestion of an examination table with the movement ranges presently claimed and does not teach of such a table, but rather focuses on a specific actuator used. The combination of a work table (Agee) that could not support a patient with a table (Blyshak) that makes no suggestion or teachings for the specifically claimed elements of the presented claims does not obviate the present claims. Allowance of claims 10-18 is requested.

## Conclusion

Applicants believe the concerns regarding claims 1-4 and 13, 15-18 and 35 U.S.C. §112 have been clarified with the above amendments and comments and allowance of these claims is requested. No new matter has been added in this amendment. Applicants have amended independent claims 1, 5, and 10 to more distinctly point out that the claims are directed towards an examination table for supporting a patient and not just any slidable table. Applicants believe the cited prior art does not show the claimed subject matter of the present application, and Allowance of claims 1-18 are respectfully requested to be passed to Allowance. If there are any outstanding issues, Applicants respectfully request that the Examiner contact the undersigned.

Respectfully Submitted,

By

  
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